

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of DuFour et al. :  
Group Art Unit 3724 : ANTIROTATION TOOL HOLDER  
Serial No. 10/553,277 : AND CUTTING INSERT  
Filed July 6, 2006 : Confirmation No. 6625  
Examiner Willmon Fridie, Jr. :

**REMARKS FOR PRE-APPEAL BRIEF CONFERENCE**

Sir:

In response to the November 25, 2008 final Office Action ("the Final Office Action") issued in the above application, Applicant requests a Pre-Appeal Brief Conference in accordance with guidelines in the "New Pre-Appeal Brief Conference Pilot Program" announcement appearing in the July 12, 2005 *Official Gazette*. In accordance with those guidelines, arguments for the conference are presented herein. Submitted concurrently herewith are: a Pre-Appeal Brief Request for Review (form PTO/SB/33); a Notice of Appeal; the fee under 37 CFR § 41.20(b)(1); and a Petition for Extension of Time and associated fee. Any deficiency or overpayment may be charged or credited, respectively, to Deposit Account No. 11-1110. The issues addressed herein are ripe for appeal in accordance with 37 CFR § 41.31(a)(1).

**Remarks**

In the Final Office Action, the Examiner rejects each of pending claims 33, 35-38, 40, 41, 44-47, and 61-65<sup>1</sup> under 35 USC § 102(b) as being anticipated by U.S. Patent No. 6,234,724 to Satran et al. ("Satran"). More particularly, in the Final Office Action the Examiner asserts that Satran inherently discloses the method recited in the pending claims. As such, the Examiner implicitly concedes that Satran does not expressly disclose every element and limitation recited in the rejected claims.

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<sup>1</sup> Claims 33, 35-38, 40, 41, 44-47, and 61-65 remained under examination in the Subject Application on entry of the amendments in Applicants' August 19, 2008 Response to Office Action. The "Office Action Summary" (page 1) of the Final Office Action accurately lists the pending claims. Page 2 of the Final

Applicants respectfully traverse the § 102(b) rejection in the Final Office Action. Applicants refer the Pre-Appeal Conference Panel to Applicants' remarks set out on pages 8-13 of the August 18, 2008 Response to Office Action (the "August 2008 Response") and to the Declaration of X. Daniel Fang attached to the August 18 Response. Applicants respectfully submit that those remarks and declaratory evidence clearly establish that the inherency rejection in the Final Office Action is unsupported and should be withdrawn, and that each of claims 33, 35-38, 40-41, 44-47, and 61-65 should be allowed.

Applicants briefly present below certain additional remarks supplementing the remarks in the August 18 Response. These additional remarks address positions the Examiner has taken in the Final Office Action and should be considered along with the August 18 Response when deciding the present pre-appeal proceeding.

Claim 64 is the single independent claim pending in the Subject Application. All other pending claims directly or ultimately depend from claim 64. Claim 64 recites:

64. A method of forming an insert pocket and an antirotation stop disposed in the insert pocket on a tool holder, the method comprising:

tangentially milling the tool holder to form the insert pocket and the antirotation stop, the insert pocket comprising a bottom face and a side wall, and the antirotation stop protruding from the side wall and comprising at least two substantially planar surfaces;

wherein tangentially milling the tool holder to form the insert pocket and the antirotation stop comprises advancing a milling cutter into the tool holder in a direction substantially parallel to the bottom face.

To establish anticipation by inherency, the Examiner must set forth a reasonable basis for the inherency assertion. As noted in the August 2008 Response, for example, MPEP § 2112(IV) states as follows:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. [citations omitted] "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing

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Office Action, however, erroneously refers to claims 32, 33, 35-41, 44-47, and 61-63 as being under examination.

may result from a given set of circumstances is not sufficient.'" [citations omitted] ...

\* \* \* \*

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

(Emphases added.)

In the Final Office Action the Examiner attempts to remedy the absence of a reasonable basis for the inherency rejection in the earlier May 16, 2008 non-final Office Action. The explanation of inherency provided in the Final Office Action, however, is unreasonable and unsupported. The explanation for inherency in the Final Office Action is as follows:

[T]he use of tangential milling to make a tool holder is old and well known in the art. Tangential-milling cutters orientate inserts so that they lie flat in the cutter rather than standing up, as in a conventional configuration. This aligns the insert's strongest cross section with the main cutting force vector. The change in configuration can double or triple edge life and improve process security in rough-milling applications while enabling higher material-removal rates. Hence tangential milling would have been a desirable method choice to one skilled in the art.

Therefore, the Examiner takes official notice, without citing any support, that tangential milling "to make a tool holder is old and well known in the art." The Examiner cannot simply take official notice of that purported fact in this case, especially when the issue is important to the consideration of patentability. MPEP § 2144.03 states that "[i]n certain circumstances where appropriate, an examiner may take official notice of facts not in the record or rely on 'common knowledge' in making a rejection, however such rejections should be judiciously applied." (Emphases added.) MPEP § 2144.03 further states:

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art.

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahler*, any facts so noticed should be of notorious character and serve only

to ‘fill in the gaps’ in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. [Citations omitted.]

This is clearly not an appropriate application of official notice. Whether or not it is “old and well known” to use tangential milling to make cutting tool insert holders is not “capable of instant and unquestionable demonstration”. This purported fact is not of a “notorious” or “insubstantial” character in connection with the rejections. Instead, the issue arguably is very significant to the question of patentability. As stated in the MPEP § 2144.03:

“It is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.” [*In re Zurko*, 258 F.3d 1379, 1385 (Fed. Cir. 2001)] (“[T]he Board cannot simply reach conclusions based on its own understanding or experience or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”). While the court explained that, “as an administrative tribunal the Board clearly has expertise in the subject matter over which it exercises jurisdiction,” it made clear that such “expertise may provide sufficient support for conclusions [only] as to peripheral issues.” *Id.* at 1385-86 [ ]. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385 [ ].

Therefore, the Examiner’s inherency-based anticipation rejection cannot be maintained for at least the reason that it lacks proper support in the Final Office Action.

Moreover, it was established in the Fang Declaration that the cutting insert pocket (52) depicted in Figure 4 of Satran could not be fully formed by tangential milling. The Examiner did not rebut or otherwise substantively address the facts presented in the Fang Declaration. In fact, the Examiner did not comment at all on the declaration beyond simply stating that it “is not deemed to be persuasive.” Applicants respectfully submit that the Office cannot apply such cursory treatment to a declaration submitted by an inventor who has substantial experience in the relevant art area and that directly addresses a significant factual issue in the examination. The Examiner has provided no explanation for dismissing the Fang Declaration. In fact, no basis exists for doing so. MPEP § 716.01 states:

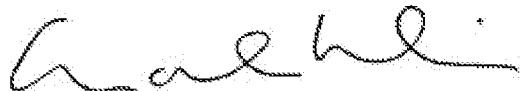
Where the evidence [presented in a declaration] is insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient. General statements such as 'the declaration lacks technical validity' or 'the evidence is not commensurate with the scope of the claims' without an explanation supporting such findings are insufficient.

Applicants respectfully submit that the uncontraverted evidence of record shows that the insert pocket of Satran could not have been fully machined using tangential milling. The Office cannot dismiss the Fang Declaration as being "unpersuasive" without providing a well-grounded technical basis for doing so.

### Conclusion

For the reasons presented in the August 18 Response and in the above remarks, the 35 USC § 102(b) rejection of claims 33, 35-38, 40-41, 44-47, and 61-65 is not properly supported or was rebutted. Applicants respectfully request that the § 102(b) rejections in the Final Office Action be withdrawn and that all claims under examination in the Subject Application be allowed.

Respectfully submitted,



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